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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,959	05/30/2001	Peter S. Banka	109887-130222	9127

25096 7590 01/11/2005

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EXAMINER	
CHEUNG, MARY DA ZHI WANG	
ART UNIT	**PAPER NUMBER**
3621	

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/870,959	BANKA ET AL.	
	Examiner	Art Unit	
	Mary Cheung	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 October 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 October 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

1. This action is in response to the amendment filed on October 22, 2004. Claims 1-34 are pending. Claims 17 and 33-34 are amended.

Drawings

2. The drawing was received on October 22, 2004. This drawing is Fig. 9.

Response to Arguments

3. Applicant's arguments filed October 22, 2004 have been fully considered but they are not persuasive.

Applicant argues that Kaplan (U. S. Patent 6,141,339) fails to teach application service contracts that specify subscriptions to application services and automatically provisioning application delivery transport to facilitate delivery of the subscribed application services. Examiner respectfully disagrees. Kaplan teaches the provider agent communicates with the user agent to establish the requirements for communications services, and the communication services provided by the provider agent are internet related services, such as intranet, voice mails (column 6 lines 37-61). The communication services in Kaplan's teaching correspond to the application service contracts as claimed by the applicant. Kaplan further teaches delivering the subscribed communications services to the user (column 6 lines 50-61), that corresponds to the claimed limitation that automatically provisioning application delivery transport to facilitate delivery of the subscribed application services.

The applicant further argues that the communication services requirements in Kaplan's teaching are a specification of the required services that are delivered to the end user, whereas the applicant's application service contract is an electronic service contract or agreement that represents a presentation method for an application. As indicated in the preceding paragraph, the application service contracts are taught by Kaplan as the communication services such as Intranet service.

Lastly, applicant argues that the services delivered by Kaplan are not automatically provisioned delivery. Examiner respectfully disagrees because the word "automatic" is defined in Dictionary (Webster Dictionary ISBN 0-395-33957-X) as "acting or performing in a mechanical or impersonal fashion", and Kaplan teaches using computer-networking devices to deliver services (column 6 lines 50-61).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 6-9, 11-14, 16, 23-25, 27-30 and 32-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Kaplan et al., U. S. Patent 6,141,339.

As to claims 1, 7, 12 and 33-34 Kaplan teaches a method and a subscriber application routing device (SAR), comprising:

a storage medium having stored therein a plurality of programming instructions, and an execution unit coupled to the storage medium for executing the plurality of programming instructions (column 17 lines14-24 and Fig. 1); and

a) providing and receiving first one or more application service contracts by a first application service provider (Provider) to a community of one or more subscriber application routers (SAR), said first one or more application service contracts specifying subscriptions to first one or more application services provided by first one or more servers of said first Provider (column 3 lines 9-27 and column 6 lines 34-61 and Figs. 1, 4);

b) automatically provisioning first one or more application delivery transports to facilitate delivery of said first one or more application services provided by said first one or more servers of said first Provider to clients of said Subscriber in accordance with said first one or more application service contracts (column 6 lines 50-65 and Figs. 1, 4);

c) providing and receiving second one or more application service contracts by a second application service provider (Provider) to the community of one or more subscriber application routers (SAR), said second one or more application service contracts specifying subscriptions to second one or more application services provided by second one or more servers of said second Provider (column 3 lines 9-27 and column 6 lines 34-61 and Figs. 1, 4);

d) automatically provisioning second one or more application delivery transports to facilitate delivery of said second one or more application services provided by

said second one or more servers of said second Provider to clients of said Subscriber in accordance with said second one or more application service contracts (column 6 lines 50-65 and Figs. 1, 4);

e) delivering and receiving selected ones of said first and second application services provided by said first and second one or more servers of said first and second Providers through selected ones of said first and second application delivery transports respectively (column 4 line 43 – column 5 line 2 and column 11 line 19 – column 12 line 9 and Figs. 1, 7).

As to claim 2, Kaplan teaches said first one or more application service contracts are provided by a community of one or more provider application routers (PARs) and said second one or more application service contracts are provided by a second community of one or more PARs (column 4 lines 39-43 and column 8 line 41 – column 9 lines 6 and Fig. 1).

As to claims 6, 27 and 32, Kaplan teaches at least one of said first one or more application delivery transports and said second one or more application delivery transports comprise one or more virtual private network tunnels (column 3 lines 59 – column 4 line 7 and column 6 line 33 – column 7 line 25).

As to claims 8 and 13, Kaplan teaches said SAR solicits said first one or more application service contracts from said first provider (column 4 line 43 – column 5 line 2 and Fig. 1).

As to claims 9 and 14, Kaplan teaches said first one or more application service contracts are received from said first provider through an encrypted control channel (column 8 lines 6-11 and column 9 lines 46-49).

As to claims 11 and 16, Kaplan teaches said automatically provisioning said first one or more application delivery transports comprises automatically provisioning a first one or more virtual private network tunnels between said SAR and said first provider (column 3 lines 59 – column 4 line 7 and column 6 line 33 – column 7 line 25).

As to claims 23 and 28, Kaplan teaches in a provider application routing device (PAR), a method comprising:

a storage medium having stored therein a plurality of programming instructions, and an execution unit coupled to the storage medium for executing the plurality of programming instructions (column 17 lines14-24 and Fig. 1); and

a) providing first one or more application service contracts to a first community of one or more subscriber application routers (SAR), said first one or more application service contracts specifying subscriptions to first one or more application services provided by first one or more servers of said Provider (column 3 lines 9-27 and column 6 lines 34-61 and Figs. 1, 4);

b) providing second one or more application service contracts to a second community of one or more subscriber application routers (SAR), said second one or more application service contracts specifying subscriptions to second one or more application services provided by second one or more servers of said Provider (column 3 lines 9-27 and column 6 lines 34-61 and Figs. 1, 4);

c) delivering selected ones of said first and second application services provided by said first and second one or more servers of said Provider through selected ones of a first one or more application delivery transports provisioned between said first community of one or more SARs and said PAR and a second one or more application delivery transports provisioned between said second community of one or more SARs and said PAR (column 4 line 43 – column 5 line 2 and column 8 line 41 – column 9 line 6 and column 11 line 19 – column 12 line 9 and Figs. 1, 7).

As to claims 24 and 29, Kaplan teaches the selected ones of said first and second application services are delivered to one or more clients of said first community of one or more SARS (column 4 line 43 – column 5 line 2 and column 8 line 41 – column 9 line 6 and column 11 line 19 – column 12 line 9 and Figs. 1, 7).

As to claims 25 and 30, Kaplan teaches said PAR is one of a community of PARs (column 4 line 43 – column 5 line 2 and Fig. 1).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were

made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan et al., U. S. Patent 6,141,339 in view of Gubbi et al., U. S. Patent 5,677,905 and Bellwood et al., U. S. Patent 6,584,567.

As to claim 3, Kaplan teaches said automatically provisioning first one or more application delivery transports further comprises: identifying, by a first SAR of said community of one or more SARs, a preferred PAR of said first community of one or more PARs (column 4 line 23 – column 5 line 2 and column 6 lines 33-61). Kaplan does not specifically teach negotiating a subnet and a shared secret between said first SAR and said preferred PAR to facilitate provisioning of said first one or more delivery transports. Gubbi teaches negotiating a subnet between subscriber and provider (column 9 lines 5-18 and column 12 lines 8-14), and Bellwood teaches negotiating a shared secret between subscriber and provider (column 4 lines 1-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Kaplan's teaching to include the feature of negotiating subnet and shared secret between subscriber and provider for providing the ultimate best contract for both the subscriber and the provider.

9. Claims 4, 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan et al., U. S. Patent 6,141,339 in view of Gubbi et al., U. S. Patent 5,677,905.

As to claim 4, Kaplan teaches providing first one or more application service contracts to a community of one or more SAR(s) as discussed above. Kaplan does not specifically teach providing one or more unapproved service contracts to a community of one or more SAR(s) for approval by the SAR(s). However, this matter is taught by Gubbi as providing, negotiating and approving contracts between two devices (column 8 line 61 – column 9 line 18 and column 12 lines 25-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Kaplan's teaching to include the feature of providing contracts for subscriber's approval for ensuring subscriber's satisfaction of the contracts.

As to claims 10 and 15, Kaplan teaches receiving first one or more application service contracts from the first application service provider as discussed above. Kaplan does not specifically teach approving at least a subset of said first one or more application service contracts received from said first provider, and transmitting said approved one or more application service contracts back to said first provider. However, Gubbi teaches providing, negotiating and approving at least a subnet and transmitting the approved contract back to the provider (column 8 line 61 – column 9 line 18 and column 12 lines 8-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Kaplan's teaching to include the feature of approving at least a subnet and transmitting the approved contract back to the provider for ensuring subscriber and provider's satisfaction of the contracts.

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan et al., U. S. Patent 6,141,339 in view of Gubbi et al., U. S. Patent 5,677,905, and in further view of Asay et al., U. S. Patent 5,903,882.

As to claim 5, Kaplan modified by Gubbi teaches providing one or more unapproved service contracts to a community of one or more SAR(s) for approval by the SAR(s) as discussed in claim 4 above. Kaplan modified by Gubbi does not specifically teach said community of one or more SAR(s) approves said one or more unapproved service contracts through manifestation of a digital signature by the approving SAR(s). However, Assay teaches using digital signatures for approving transactions (column 1 line 53 – column 2 line 20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the teaching of Kaplan modified by Gubbi to include the feature of using digital signatures for approving the contracts for better securing the contract approving process.

11. Claims 17-22, 26 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan et al., U. S. Patent 6,141,339 in view of Li, U. S. Patent 6,707,796.

As to claims 17 and 20, Kaplan teaches in a subscriber application routing device (SAR), comprising:

a storage medium having stored therein a plurality of programming instructions, and an execution unit coupled to the storage medium for executing the plurality of programming instructions (column 17 lines14-24 and Fig. 1); and

a) receiving one or more application service contracts from an application service provider (Provider), said one or more application service contracts

specifying subscriptions to one or more application services provided by one or more servers of said Provider (column 3 lines 9-27 and column 6 lines 34-61 and Figs. 1, 4);

b) automatically provisioning one or more application delivery transports between said SAR and a selected one or more of PARs to facilitate delivery of said one or more application services provided by said one or more servers of said Provider to clients of said Subscriber in accordance with said one or more application service contracts (column 6 lines 50-65 and Figs. 1, 4);

c) receiving selected ones of said application services provided by said one or more servers of said Provider through selected ones of said application delivery transports respectively (column 4 line 43 – column 5 line 2 and column 11 line 19 – column 12 line 9 and Figs. 1, 7).

As to claims 17, 20, 26 and 31, Kaplan does not specifically teach requesting from the Provider a list of provider application routers (PARs) identified as being able to support a given contract of said one or more application service contracts. However, Li teaches providing a list of routers that the system supports (column 10 lines 1-17). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Kaplan's teaching to include the feature of providing a list of validated PARs because this would allow the subscribers or other users to make an easy and better decision to select PARs.

As to claims 26 and 31, Kaplan modified by Li does specifically teach notifying said first community of one or more SARs as to which PARs are able to support the

selected one of said first one or more application service contracts. It would have been obvious to one of ordinary skill in the art to allow the teaching of Kaplan modified by Li to include the feature of notifying the SARs as claimed for reducing the confusion of which routers to be used.

As to claims 18 and 21, Kaplan modified by Li does not specifically teach said selected one or more of said listed PARs are selected by the SAR based at least in part upon response times of the respective PARs. It would have been obvious to one of ordinary skill in the art to allow the teaching of Kaplan modified by Li to include selecting PARs within the response times for efficient allocation of the routers.

As to claims 19 and 22, Kaplan teaches wherein automatically provisioning one or more application delivery transports comprises establishing one or more virtual private network tunnels between said SAR and said selected one or more PARs (column 3 lines 59 – column 4 line 7 and column 6 line 33 – column 7 line 25).

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final Communications labeled "BOX AF")

(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Plaza Two, Room 1B03.

Mary Cheung
Patent Examiner
Art Unit 3621
January 10, 2005